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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,912	12/07/2006	Kenji Yamaguchi	278542014100	3804
25225 7590 01/19/2010 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER MAGLOIRE, VLADIMIR				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,912

Applicant(s)

YAMAGUCHI, KENJI

Examiner

VLADIMIR MAGLOIRE

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments with respect to claims 1 to 13 have been considered but are moot in view of the new ground(s) of rejection.
2. Based on the amendments of claim 1, the 35 USC 112 second paragraph rejection of claim 1 is withdrawn.
3. The amendment to the term "telephone numbers" on page 12 of the specification is approved.
4. The applicant argues that "the structure disclosed in Satoh would not allow for creating list information, which has a small data size, from information relating to targets, which has a large data size nor obtaining information relating to specific targets based on the list thus created.", however these limitations are not part of the claim language. It is noted that the features upon which applicant relies (i.e., creating list information, which has a small data size, from information relating to targets, which has a large data size) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant further argues that Satoh neither teaches nor suggest any technology that corresponds to the creating unit and the mail transmitting unit as recited in amended claim 1. The examiner respectfully disagrees. Satoh discusses a terminal device which creates new mail and transmit mail therefore is showing "the creating unit and the mail transmitting unit as recited in amended claim 1". For further elaboration see the references cited in the rejection following.

6. With regards to the applicants 35 USC 103 (a) arguments, the arguments have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 6, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Satoh (EP 0881 587 A2).

Consider claim 1, Satoh discloses a terminal device (**see Satoh, page 7 lines 8 to 12, discloses the proxy server is a notebook PC, Palm Top PC, or a communication terminal**) for transmitting and receiving mails (**see Satoh, fig. 1 item 15, fig. 2 item 220**), comprising:

a mail receiving unit (**see Satoh, fig. 2 item 220**);

a judging unit to judge whether a command declaration is included in a received mail (**see Satoh, fig. 1 item 1, fig. 9 item 413, page 10 lines 46 to 47**);

a command interpreting unit to extract and interpret a specific command following the command declaration if the judgment of the judging unit is affirmative (**see Satoh, fig. 1 item 1, fig. 9 item 413, page 10 lines 46 to 47, page 11 lines 4 to 33**);

a creating unit (**see Satoh, page 10 lines 46 to 47, discloses a mail interpreter**) to, if the specific command is interpreted as target list creation an

instruction to create a list of one or more targets (**see Satoh, page 11 lines 14 to 22, discloses the mail interpreter interprets the command “#fileg” as a file list creation command**), which are specified by the specific command, create (**see Satoh, page 11 lines 14 to 22, discloses the mail interpreter interprets the command “#fileg” as a file list creation command**), from the targets stored in memory of the terminal device (**see Satoh, page 11 lines 14 to 22, lines 40 to 45, discloses the requested files are retrieved from the server “terminal device” and Table 2. discloses files are stored on the “C” drive, therefore from the memory of the server**) the list of the one or more targets which are specified by the specific command (**see Satoh, page 11 lines 14 to 22**); and

a mail transmitting unit to create and transmit a mail having the created list as a mail body and addressed to a requester (**see Satoh, fig. 8, discloses an email request, item 300, and the subsequent response, item 330, with the target list**).

Consider claim 2, the terminal device of claim 1, further comprising: a comparing unit operable to detect, if a password accompanies the command declaration and the judgment of the judging unit is affirmative, the password, and compare the password with a password owned by the terminal device; and an authorizing unit operable to authorize the extraction and interpretation of the specific command if the passwords match each other (**see Satoh, page 10 lines 39 to 45**).

Consider claim 3, the terminal device of claim 1, wherein the command declaration is a unique character string different from a mail text, and the specific command is a line of code including a storage location of the targets, a type of the

targets, and a process to be performed (see Satoh, page 9 lines 4 to 27, page 11 lines 14 to 22).

Consider claim 5, Satoh discloses if a specific command transmitted by the requestor after the requestor checks the list of the mail is a request of transmitting a specific item in the list, the specific item is read from the memory, and a mail having the read specific item as a mail main body and addressed to the requestor is created and transmitted (see Satoh, fig. 8, item 300 discloses a request for a list stored in a specific memory location, item 310 "C:YSALESYREPORT1.TXT", which is then transmitted backed to the requestor in the main body of email as shown in item 330).

Consider claim 6, the terminal device of claim 1, wherein if a specific command transmitted by the requestor after the requestor checks the list of the mail is a request of deleting a specific item in the list, the specific item is deleted from the memory (see Satoh, page 11 lines 10 to 13).

Consider claim 9, the terminal device of claim 1, wherein if the targets are schedules of events, a date, a time, and an icon indicating a type of an event are displayed in the list, with respect to each of the schedules of events (examiner takes official notice that providing event time, date and image of an event was well known at the time of the invention).

Consider claim 10, the terminal device of claim 1, wherein if the targets are images, a shooting date, a title, an address in which an image is stored are displayed in the list, with respect to each of the images (examiner takes official notice that

providing image time, title, and storage location of an image was well known at the time of the invention).

Consider claim 11, the terminal device of claim 1, being a mobile phone **(see Satoh, page 7 lines 8 to 12, discloses the proxy server is a communication terminal, therefore a mobile phone).**

Consider claim 12, the terminal device of claim 2, wherein the command declaration is a unique character string different from a mail text, and the specific command is a line of code including a storage location of the targets, a type of the targets, and a process to be performed **(see Satoh, page 9 lines 4 to 27, page 11 lines 14 to 22).**

8. Claim 4, 7, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh.

Consider claims 4 and 13, the terminal device of claim 3, Satoh discloses the targets are received mails, transmitted mails, schedules of events, images, an address book, received voice calls, or transmitted voice calls **(see Satoh, page 8 lines 4 to 11, discloses accessing scheduling information and mail information from a remote computer).**

Satoh does not specifically disclose the scheduling information is stored in the server, however, since Satoh discloses files are stored on the hard drive of the server (see claim 1) it would have been obvious, if not inherent, to one of ordinary skill in the art to have the scheduling information stored in the server, thereby providing faster search of files.

Consider claim 7, the terminal device of claim 6, Satoh discloses indication completion of files that are sent and when there is an error, however Satoh does not specifically disclose wherein a mail having a main body which indicates completion of the deletion and addressed to the requestor is created and transmitted.

Since Satoh, discloses sending mail for the above reasons, it would have been obvious to one of ordinary skill in the art at the time of the invention to use conventional techniques such as a confirmation message sent that an action was completed, such as deletion of a file, thereby providing greater assurance that a task was completed.

9. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh in view of Day (US 2003/0224760 A1).

Consider claim 8, the terminal device of claim 1, the combination of Heureux and Satoh do not specifically disclose if the targets are received mails, at least a sender, a received date, and a subject are displayed in the list, with respect to each of the received mails.

Day discloses if the targets are received mails, at least a sender, a received date, and a subject are displayed in the list, with respect to each of the received mails (**see Day, paragraphs [0037-0039], discloses providing a list with the sender, received date and subject with respect to each received email**).

Providing a list of received emails, with the associated sender, subject and date was a well known technique at the time of the invention, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Satoh by

adding details of received emails to the list of retrieved files, as taught by Day, thereby allowing greater user flexibility (see Day, paragraph [0005]).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **VLADIMIR MAGLOIRE** whose telephone number is (571)270-5144. The examiner can normally be reached on Monday to Thursday, 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on 571-272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NICK CORSARO/
Supervisory Patent Examiner, Art Unit 2617

/Vladimir Magloire/
Examiner, Art Unit 2617 1/8/10